



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/964,257	11/04/1997	HITOSHI TERASHIMA	56356	2047

23872 7590 10/18/2005
MCGLEW & TUTTLE, PC
P.O. BOX 9227
SCARBOROUGH STATION
SCARBOROUGH, NY 10510-9227

EXAMINER	
NGUYEN, MADELEINE ANH VINH	
ART UNIT	PAPER NUMBER
2626	

DATE MAILED: 10/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

08/964,257

Applicant(s)

TERASHIMA ET AL.

Examiner

Madeleine AV Nguyen

Art Unit

2626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 April 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 7-10, 19-25, 34-36, 38-50 and 52-61 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 7-10, 19-25, 34-36, 38-50 and 52-61 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>10/19/04, 11/18/04, 1/11/05, 4/22/05</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after allowance or after an Office action under *Ex Parte Quayle*, 25 USPQ 74, 453 O.G. 213 (Comm'r Pat. 1935). Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, prosecution in this application has been reopened pursuant to 37 CFR 1.114.

Applicant's submission filed on April 22, 2005 has been entered.

Allowable Subject Matter

2. Prosecution on the merits of this application is reopened on claims 7-10, 19-25, 34-36, 38-50, 52-61 considered unpatentable for the reasons indicated below:

The indicated allowability of the above claims is withdrawn in view of the reference to Tajima (Japanese Patent No. JP403003030A). Rejections based on the newly cited reference follow.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Art Unit: 2626

4. Claims 7-9 are rejected under 35 U.S.C. 102(b) as being anticipated by Tajima (Japanese Patent No. JP403003030A).

Concerning claim 7, Tajima discloses an apparatus (Fig.1) comprising a base apparatus (3) which includes first sheet transporting path (3a) extending substantially vertically and perform a first processing for a sheet traveling downward along all length of the first sheet transporting path; and a scanner apparatus (2) which can be removable mounted on the base apparatus and includes a reading element (Fig.5); wherein a second sheet transporting path (5) extending substantially vertically is defined by a surface of the scanner apparatus on which the reading element is provided, and a surface of the base apparatus which faces to the scanner apparatus in case where the scanner apparatus is mounted on the base apparatus (Fig.2), and a second sheet travels downward along all length of the second transporting path; and wherein the scanner apparatus (Fig.5) includes a pick roller (20) provided at a location upstream of the second sheet transporting path and viewed in a sheet transporting direction and includes a feed roller (21) provided at locations downstream of the second sheet transporting path, the first and second sheet transporting paths being provided along and adjacent and nearly parallel to each other at their straight guide parts of the upper portion, and the first and second sheet delivery ports are provided at a same side of the apparatus (Figs.1-2); and wherein the scanner apparatus is so implemented as to be capable of operating as a hand scanner is a case where the scanner apparatus is detached from the base apparatus (Abstract).

Concerning claims 8-9, Tajima further teaches the scanner apparatus has a protecting member to provided in a manner projecting at a side of the surface of the scanner apparatus, to protect the pick roller from collapsing with the weight of the scanner apparatus in a case where

Art Unit: 2626

the scanner apparatus is used as a hand scanner and the protecting member is provided at a location outside of a reading area of the scanner apparatus (claims 8-9), (Figs.1, 5).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tajima as applied to claim 7 above, and further in view of Shimizu (US Patent No. 5,663,811).

Concerning claim 10, Tajima fails to teach a groove to receive the protecting member is a case where the scanner apparatus is mounted on the base apparatus is provided in the surface of the base apparatus facing toward the protecting member. However, it is a matter of well known in the art at the time the invention was made to have a groove in Tajima to better hold the hand scanner mounted on the base apparatus. Shimizu supports the well-known prior art by teaching a hand-held scanner mounted on a base apparatus having the groove to receive and hold the hand-held scanner (Fig.3). It would have been obvious to one skilled in the art at the time the invention was made as a matter of well known in the art supported by Shimizu to have a groove on the surface of the base apparatus facing toward the protecting member in order to hold the scanning part 2 since Tajima teaches that the scanner part 2 is attachable/detachable fitted on the recessed part 3 while does not limit any supporting mechanism for holding the scanning part 2.

Art Unit: 2626

7. Claims 19-25, 34-36, 46-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tajima in view of Shimizu (US Patent No. 5,663,811).

Concerning claims 19, 46, Tajima discloses the apparatus as discussed in claim 7 above.

Tajima fails to teach an engaging portion and a scanner mounting portion wherein either of them is a pivotal shaft for allowing the scanner apparatus to rotate frontward while the other is in the form of a holding member for holding the pivotal shaft. However, it is a matter of well known in the art at the time the invention was made to have a pivotal shaft in Tajima to better hold the hand scanner mounted on the base apparatus since a pivotal shaft for allowing any device to rotate frontward while a mounting portion is in the form of a holding member for holding the pivotal shaft has been known. In addition, it is a matter of design choice to have an engaging portion to engage any device on a mounting portion. Shimizu supports the well known prior art by teaching a hand-held scanner mounted on a base apparatus having an engaging portion to allow the scanner apparatus to rotate frontward while the other is in the form of a holding member for holding the pivotal shaft receive and hold the hand-held scanner (Figs. 1, 5). It would have been obvious to one skilled in the art at the time the invention was made as a matter of well known in the art and a matter of design choice, supported by Shimizu to use a pivotal shaft for allowing a scanning apparatus to rotate frontward while the mounting portion is in the form of a holding member for holding the pivotal shaft since Tajima teaches that the scanner part 2 is attachable/detachable fitted on the recessed part 3 while does not limit any supporting mechanism for holding the scanning part 2.

Art Unit: 2626

Concerning claims 20, 25, Tajima further teaches that the scanner apparatus is so implemented as to be capable of operating as a hand scanner in a case where the scanner apparatus is detached from the base unit (Fig.1).

Concerning claims 21, 22, 23, 48-50, Tajima does not teach a lock member locking the scanner apparatus is a stated mounted on the base unit, a stopper preventing the scanner apparatus for swinging excessively frontward of the apparatus in case the scanner is attached to or detached from the base unit, and a deviation preventing the scanner apparatus from displacing upwardly in a case where the scanner is mounted on the base unit. However, it was a matter of well known in the art and a matter of design choice to have a lock member locking the scanner apparatus since a lock member and a stopper are well-known to lock any device on a mounting base unit and to stop a device from swinging excessively frontward. Shimizu supports the well known prior art by teaching a hand-held scanner mounted on a base apparatus having an engaging portion to allow the scanner apparatus to rotate frontward while the other is in the form of a holding member or a stopper for holding or stopping the scanner (Fig.3). It would have been obvious to one skilled in the art at the time the invention was made as a matter of well known in the art and a matter of design choice to use a lock member to lock the scanner apparatus is a stated mounted on the base unit and a stopper for preventing the scanner apparatus for swinging excessively frontward of the apparatus in case the scanner is attached to or detached from the base unit since Tajima teaches that the scanner part 2 is attachable/detachable fitted on the recessed part 3 while does not limit any supporting mechanism for holding the scanning part 2.

Concerning claim 24, Tajima in view of Shimizu discloses the apparatus discussed in claim 19 above. Tajima further teaches a sheet guide provided on the scanner apparatus and a

Art Unit: 2626

sheet guide provided on the base unit which are faced each other, and offset member is provided for at least one of the said two sheets guides for stepwise limiting moving of a sheet toward the sheet withdrawing port (Figs.1, 5).

Tajima does not teach that the space between two sheet guides becomes gradually narrower toward a sheet withdrawal port. However, it is a matter of design choice to have any two sheets guide path parallel or not. Shimizu supports the well-known design choice of 2 sheets guide paths having a space gradually narrower toward a sheet withdrawal port (Fig.4). It would have been obvious to one skilled in the art at the time the invention was made as a matter of design choice to modify the two sheet guide paths having a space gradually narrower toward a sheet withdrawal port as a matter of design choice, supported by Shimizu since both of the designs have the same result for guiding the sheets toward withdrawal ports.

Concerning claim 34, Tajima in view of Shimizu discloses the apparatus discussed in claim 24 above. Tajima further teaches that the base apparatus includes a first sheet guide (3a) provided at a location upstream of the second sheet transporting path (5) and the scanner apparatus includes a second sheet guide provided at a location upstream of the second sheet transporting path (Figs.1, 5).

Concerning claims 35-36, Tajima further teaches that the scanner apparatus includes a pick roller (20) provided at a location upstream of the second sheet transporting path and viewed in a sheet transporting direction and includes a feed roller (21) provided at locations downstream of the second sheet transporting path and the protecting member is provided at a location outside of a reading area of the scanner apparatus (Figs.5-6).

Art Unit: 2626

Concerning claim 47, Tajima further teaches a sheet transporting direction of the sheet transporting path is substantially vertical, and Shimizu further teaches the engaging portion and the scanner mounting portion hold the scanner such that the scanner can rotate about a lower portion (Figs. 1, 5).

8. Claims 38-40, 42-45, 52-61 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shimizu.

Concerning claim 38, Shimizu discloses a multiple function apparatus comprising a base unit; a first transporting guide (100c); a first apparatus (printing unit 4 in the body) provide at a deflecting guide part and performing processing for the first sheet; a second transporting guide (200c), a second apparatus (scanning unit 5) for performing processing of the second sheet wherein the second apparatus is a removable mounted on the base unit and includes a reading element and being implemented as a hand scanner in a case where the scanner apparatus is detached from the base unit wherein a portion of the second transporting guide is movable so that the body including the first apparatus can be exposed.

Shimizu does not teach that the first apparatus can be exposed when the hand scanner is detached from the base unit. However, since the part of the body including the printing unit 4 is exposed, it would have been obvious to one skilled in the art at the time the invention was made to have the printing unit 4 exposed in the upper part or in the lower part of the body as a matter of design choice since the body of the first apparatus can be exposed either way.

Concerning claim 39-40, 42, 44, 45, Shimizu further teaches that the second apparatus is provided opposite of the first transporting guide (claim 39), the directions of transport of the first

Art Unit: 2626

sheet and second sheet form an angle smaller than 90 degrees (claim 40); the second transporting guide is provided closer to the front side, the first apparatus is an image forming apparatus, the second apparatus is a scanner (claim 42); a portion of the second transporting guide (the scanner) is movable (claim 44); the first apparatus and second apparatus are provided to overlap each other (claim 45).

Concerning claim 43, Shimizu does not directly teach a cover, which is a portion of the second transporting guide to cover the image forming apparatus. However, From Fig.3-4, the mounting portion of the base has a vertical part as a portion of a transporting guide and as a part of a cover. It would have been obvious to one skilled in the art at the time the invention was made to consider the vertical straight part of the apparatus is a cover part of the image forming apparatus since it protect the parts inside the body of the apparatus.

Concerning claims 52, 59, Shimizu teaches an apparatus as discussed in claim 38 above.

Shimizu does not directly teach a cover which is a portion of the second transporting guide to cover the image forming apparatus. However, From Fig.3-4, the mounting portion of the base has a vertical part as a portion of a transporting guide and as a part of a cover. It would have been obvious to one skilled in the art at the time the invention was made to consider the vertical straight part of the apparatus is a cover part of the image forming apparatus since it protect the parts inside the body of the apparatus.

Concerning claims 53-54, Shimizu fails to teach a cover that can be opened and closed or the cover can be removed. However, it a matter of design choice to have such cover since a cover, which can be opened and closed or removed, is commonly used for cover any device. It would have been obvious to one skilled in the art at the time the invention was made as a matter

Art Unit: 2626

of design choice to have a cover which can be opened and closed or the cover can be removed since Shimizu also teaches a cover 100c which can be open or closed or a cover (scanner) which can be removed.

Concerning claims 55-58, Shimizu further teaches that the base apparatus is an image forming apparatus (claim 55); a sheet guide of the image forming apparatus and a sheet guide of the scanner apparatus are provided adjacent to each other (claims 56-57); a sheet feeding portion of the scanner is provide frontward (claim 58).

Concerning claims 60-61, Shimizu further teaches a hand-held scanner, which includes at least one roller for sheet transportation, a center of rotation located at a downstream side.

9. Claim 41 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shimizu as applied to claim 38 above, and further in view of Tajima.

Concerning claim 41, Shimizu further teaches a first transporting mechanism transporting the first sheet from the straight guide part toward the deflecting guide part; a second transporting mechanism transporting the second sheet. Shimizu fails to teach that the direction of the second sheet is in substantially a same direction as the first sheet. However, it is a matter of design choice to have the first and second sheet transports having the same direction. Tajima discloses a system having a detachable scanner mounted on a base unit having two transporting mechanisms wherein the direction of the first and second sheets are in substantially the same direction. It would have been obvious to one skilled in the art at the time the invention was made as a matter of design choice to have the first and second sheet direction at the same direction as a matter of

Art Unit: 2626

design choice supported by Tajima since both ways can transport the sheets to the withdrawing ports.

Conclusion

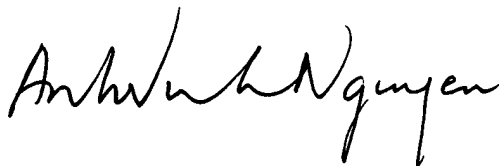
10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a. Yamada (US Patent No. 5,335,090) discloses an image reading apparatus having detachable optical system.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Madeleine AV Nguyen whose telephone number is 571 272-7466. The examiner can normally be reached on Monday, Tuesday, Thursday 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly A. Williams can be reached on 571 272-7471. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Madeleine AV Nguyen
Primary Examiner
Art Unit 2626

Application/Control Number: 08/964,257

Page 12

Art Unit: 2626

October 15, 2005